

REMARKS

Preliminarily, Applicants respectfully request the Examiner to return initialed Form PTO/SB/08 A & B (modified) for the Information Disclosure Statement filed December 18, 2002.

Claims 15-22 drawn to a non-elected invention have been canceled. Applicants reserve the right to file a divisional application directed to the canceled subject matter.

Review and reconsideration on the merits are requested.

Responsive to the objection, the specification at pages 13 and 16 has been amended to correct the noted informalities. Withdrawal is respectfully requested.

Claims 1-14 were rejected under 35 U.S.C. § 112, second paragraph. Particularly, the Examiner considered that (i) the specification fails to clearly define the scope of the claimed “silver salt of an organic acid”. Additionally, (ii) the Examiner considered the term “dispersoid” in claim 11 to be indefinite. As to claim 12, (iii) the Examiner inquired as to the basis for the limitation of 1-10 weight %. As to claim 10, (iv) the Examiner considered that the claim does not adequately distinguish the step of preparing the silver salt grains from the dispersion operation, and further considered that the claim was unclear as to when the dispersing agent is used.

The Examiner’s comments (i) to (iv) are addressed in turn, as follows.

(i) The “organic acid” of the silver salt of an organic acid is described at page 14, lines 15-34 of the specification. Particularly, the organic acid moiety is selected from those stable to light at an ambient temperature as a silver salt, but producing a silver image when its silver salt is heated at 80°C or higher in the presence of a light exposed photocatalyst. The

organic acid is preferably long chain aliphatic carboxylic acid containing 10-30 carbon atoms, more preferably 15-28 carbon atoms. Preferred examples thereof are given at page 14, lines 26-34 of the specification. Thus, one of ordinary skill can readily determine the scope of the claimed "silver salt of an organic acid".

(ii) The term "dispersoid" refers to suspended particles in a dispersion. These are the grains of silver salt of an organic acid. Thus, claim 11 has been amended to recite that the dispersing agent is used at a concentration of [1-30] 0.1-30 weight % of [dispersoid] said grains of silver salt of an organic acid. See, for example, page 23, lines 6-13 of the specification, including support for the broader range.

(iii) The concentration of grains of silver salt of an organic acid immediately after the reaction is discussed at page 18, lines 13-20 of the specification. That is, the content of the grains of silver salt of an organic acid is given in terms of the weight % of the reaction medium, namely, the solution containing silver ions and the solution containing an alkali metal salt of an organic acid.

(iv) As discussed bridging pages 21-22 of the specification, the dispersing agent is preferably added to the system before the start of the reaction or before completion of the purification using an ultrafiltration membrane. The dispersing agent may be contained in any of the solution containing silver ions, the solution containing an organic acid alkali metal salt or the solution put into the reaction vessel beforehand. The dispersing agent may also be added separately as a dispersing agent, or added as an additive comprising the dispersing agent and other components. This is entirely consistent with claim 10 which only requires the dispersion

operation to be performed in the presence of a dispersing agent. There is no limitation, and none is intended, with respect to the time or place of addition (so long as the dispersion operation is carried in the presence of the dispersing agent). Claim 10 has been amended to recite positive manipulative steps, and to more clearly define a first reacting step, a dispersing step and then a removing step.

It is respectfully submitted that the claims as amended fully comply with 35 U.S.C. § 112, and withdrawal of the foregoing rejection is respectfully requested.

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 6,472,546 to Kawanishi et al.

In response, the undersigned states that Application No. 09/893,750 and U.S. Patent 6,472,546 were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person, namely, Fuji Photo Film Co., Ltd. of Kanagawa, Japan. U.S. Patent 6,472,546 is therefore disqualified as a reference under 35 U.S.C. § 103(c).

U.S. Patent 6,472,546 was issued on October 29, 2002, subsequent to the June 29, 2001, filing date of the present application, and therefore is not available as prior art under any of § 102(a) and § 102(b). Because the present application and U.S. Patent 6,472,546 were commonly owned by the same person at the time of the invention of the present application, U.S. Patent 6,472,546 is disqualified as prior art under § 102(e)/103(a).

Withdrawal of the foregoing rejection is respectfully requested.

Claims 1-9 were rejected under the judicially created doctrine or obviousness-type double patenting over claims 1-5 of U.S. Patent 6,472,546.

In response to the obviousness-type double patenting rejection, over claims 1-5 of U.S. Patent 6,472,546, the Assignee submits herewith a Terminal Disclaimer disclaiming the terminal part of any patent granted on the above-identified application which would extend beyond the expiration of full statutory term as presently shortened by any Terminal Disclaimer of U.S. Patent 6,472,546.

Withdrawal of the obviousness-type double patenting rejection is respectfully requested.

Claims 10-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1 063 566. The Examiner considered EP '566 (Abstract, pages 31-32, claims 1-19 and Fig. 1) as disclosing a process of forming grains of silver salt of an organic acid, dispersing in the presence of a dispersing agent, and then removing by-product salts by ultra-filtration.

In response, Applicants submit herewith the verified English translation of Japanese Patent Application No. 2000-236044 upon which Applicants claim priority under 35 U.S.C. § 119, to thereby perfect their claim to priority as to Claims 10-14. The August 3, 2000 filing date of Japanese Patent Application No. 2000-236044 antedates the December 27, 2000 publication date of EP '566, to thereby obviate the rejection. Rejected Claims 10-14 are fully supported by the priority document.

Withdrawal of the foregoing rejection is respectfully requested.

Withdrawal of all rejections and allowance of claims 1-14 is earnestly solicited.

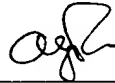
In the event that the Examiner feels that it may be helpful to advance the prosecution of the present application, the Examiner is invited to contact the undersigned at the local Washington, D.C. telephone number indicated below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 09/893,750

Q64948

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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